

Remarks

Applicant has amended claims 1 and 13. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. (See, Pars. 18-20; FIGS. 3-5) Entry of the amendment and favorable consideration thereof is earnestly requested.

Claim 1 recites among other limitations "a tubular member including a continuous wall to form a closed interior" and "a sheath comprising at least the following layers: a braided layer; a laminating layer; a wear layer; a barrier layer comprising a polyester wrap is disposed between the continuous wall of said tubular member and the braided layer and jackets the tubular member to form a seal therebetween." Claim 13 recites among other limitations an "a tubular member including a continuous wall to form a closed interior" and "a barrier layer jacketing the tubular member to form a seal around said continuous wall of said tubular member; a braided layer jacketing the barrier layer; a laminating layer; a wear layer; wherein at least said barrier layer, said braided layer and said laminating layer are formed as a single composite structure." Applicant respectfully submits that these limitations are not disclosed or taught in the cited prior art.

The Examiner has submitted that Abe et al. (U.S. Patent No. 6,540,669) discloses an endoscope shaft having "an endoscope insertion shaft comprising: a tubular member 21 having an axis and including at least one aperture 25 for increasing the flexibility thereof" and "a sheath comprising at least the following layer: a braided layer 22, a laminating layer 33, a wear layer 34, wherein the braided layer jackets the tubular member; and a barrier layer 231 comprising a polyester wrap disposed between the tubular member and the braided layer and jacketing the tubular member (see Figs. 3-5 and Col. 6, Lines 22-30)." (Official Action 5/4/07, p. 2) Applicants respectfully disagree.

For example, while the Examiner has pointed to (21) as forming a tubular member, Abe et al. discloses that the "core body 2" is "constructed from helical coil 21." (Col. 4, Ins. 61-2) As amended, claims 1 and 13 recite a tubular member including a continuous wall to form a closed interior. Accordingly, as Abe et al. fails to disclose a tubular member including a continuous wall to form a closed interior, Abe et al. cannot anticipate the pending claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, it would not be obvious to replace the "helical coil 21" with a tubular member including a continuous wall according to the pending claims as this would reduce the flexibility of the structure. (See e.g., Col. 5, Ins. 1-6; *In re Gordon*, 733 F.2d 900, 221 USPQ2d 1125 (Fed. Cir. 1984) (modification cannot render the prior art invention unsatisfactory for its intended purpose). Accordingly, Abe et al. cannot render claims 1 or 13 obvious.

Applicants further submit that Abe et al. fails to disclose or teach a barrier layer jacketing the tubular member to form a seal around said continuous wall of the tubular member as variously recited in claims 1 and 13. For example, while the Examiner has equated "coating layer 231" with the "barrier layer", Applicants note that Abe et al. discloses "reticular tube (braided member) 22 is formed by braiding a plurality of metals or nonmetal fine wires 23 into a tubular lattice structure" and that "in FIG. 3, there is formed a coating layer 231 over a least one of the fine wires 23." (Col. 5, Ins. 12-14 & 20-1) As depicted in FIG. 3, the coating layer surrounds one of the "fine wires 23" that comprise the braided layer. Accordingly, the coating layer does not "form a seal around said continuous wall of the tubular member" as recited in claims 1 and 13. Accordingly, because Abe et al. fails to disclose a barrier layer jacketing the tubular member to form a seal around said continuous wall of the tubular member as variously recited in claims 1 and 13, Abe et al. cannot anticipate these claims. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In addition, it would not be obvious to modify the "coating layer 231" taught in Abe et al. according to pending claims 1 and 13. Abe et al. never contemplated using

this "coating layer 231" to form a barrier, rather, as specifically disclosed in Abe et al., it was provided so that "it becomes possible to strongly bond (fuse together) the coating layer 231 and the outer cover 3, as shown in FIG. 4" with "the adhesion (bonding strength) between the reticular tube 22 and the outer cover 3 is enhanced." (Col. 5, Ins. 29-33) As can be seen in FIG. 4, the "coating layer 231" contacts "outer cover 3", however, there is no seal created between "helical coil 21" and "outer cover 3" by "coating layer 231" as recited in claims 1 and 13.

Applicant notes that there must be some reason or motivation found in the prior art for making a suggested modification and that it is impermissible to assemble the prior art using the pending claims as a roadmap to select various features and make selected modifications where there is no motivation in the references themselves for doing so. See e.g. *W.L. Gore and Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13, (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In the present case, Applicants respectfully submit that Abe et al. never contemplated forming a barrier layer between the "helical coil 21" and "outer cover 3" as recited in claims 1 and 13. The "coating layer 231" pointed to by the Examiner is merely a coating around one particular strand of the "braided member 22" and is provided to increase bonding between the layers. Even if one was to encase every single, which Applicants note is not even hinted at or suggested in Abe et al., one would still not arrive at a barrier layer jacketing the tubular member to form a seal around said continuous wall of the tubular member as variously recited in claims 1 and 13. Accordingly, Applicants respectfully submit that the pending claims cannot be obvious in view of Abe et al.

It is respectfully submitted that claims 1-7 and 10-13, all of the claims remaining in the application, are in order for allowance and early notice to that effect is respectfully requested.

Respectfully submitted,

July 2, 2007

/Wesley W. Whitmyer, Jr./
Wesley W. Whitmyer, Jr., Registration No. 33,558
Steven B. Simonis, Registration No. 54,449
Attorneys for Applicants
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
Tel. 203 324-6155